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10/691,286	10/22/2003	Thomas C. Chuang	0031000	4915

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RUHL, DENNIS WILLIAM	
ART UNIT	**PAPER NUMBER**
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10691286	10/22/03	CHUANG, THOMAS C.	0031000

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ART UNIT	**PAPER**
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Commissioner for Patents

In response to the "Order Returning Undocketed Appeal to Examiner", attached is a copy of an Examiner's answer that includes the grounds of rejection from the Final office action. Also, with respect to the headings used in the examiner's answer, the headings used at that time were believed to be proper and were taken directly from OACS. The return to the examiner did not specifically state that new headings were required; however, the examiner has changed two headings to be what is believed to be the proper current headings.

DENNIS RUHL
PRIMARY EXAMINER

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/691,286
Filing Date: October 22, 2003
Appellant(s): CHUANG, THOMAS C.

Thomas C. Chuang
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/10/06.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 9/15/05 has been entered.

(5) Summary of Claimed Subject Matter

The summary of invention contained in the brief is inaccurate because some of the comments applicant has made about the invention do not have proper support in the specification as originally filed. This is an issue that is pending in the instant appeal. The summary is commensurate with applicant's arguments traversing the rejections of record but in the opinion of the examiner the summary is not commensurate with the scope of the invention disclosed in the specification as originally filed.

(6) Grounds of rejection to be reviewed upon Appeal (applicant has this section listed as "Issues")

1. The amendment filed 4/25/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: See the 112,1st rejection of the claims where this is explained in detail by the examiner.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 23-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

For claim 23,29, the specification as originally filed did not disclose the claimed limitations of status identifiers of "available" and "unavailable" as claimed. The specification discloses that the rental queue is divided into three separate lists that are "Checked out", "DVD's in Queue", and "Awaiting Release". The examiner cannot find any disclosure of "available" and "unavailable" as claimed. The examiner feels that absent any showing of support for the newly added language from the specification as originally filed that these limitations must be considered as new matter. Also considered

to be new matter is the recitation that the optimized purchase price is generated by searching all of the user's data queue structures to identify the frequency of appearance of the disk identifier. Where was this disclosed in the specification as originally filed? The generation of a purchase price for a disk that is in a checked out status is disclosed with respect to figure 5B in the specification (paragraphs 50-55). The examiner does not see where it has been disclosed that the optimized purchase price is generated by searching all of the user's data queue structures to identify the frequency of appearance of the disk identifier. It is disclosed that in one embodiment the purchase price is the wholesale price paid by the web site plus the desired profit. Another embodiment is using a baseline price determined by current market demand. Neither of these two embodiments support what is claimed. Paragraph 51 discusses the determination of how many copies the web site owns for the disk the price is being generated for. It is stated that the historical and current rental patterns are looked at but this does not seem to provide support for "searching all of the user's data queue structures to identify the frequency of appearance of the disk identifier". The examiner does not see where this limitation was disclosed in the specification as originally filed.

For claim 24, the specification as originally filed did not disclose that additional packaging is provided to the purchaser. Additional disks are disclosed as being offered but not packaging. A product like a disk and packaging that is used to package an article are two entirely different things. Where is support for what is claimed found in the specification as originally filed?

For claims 25,30, applicant is claiming the requesting of a purchase price for a disk with an available status. To start with, the examiner is not clear as to what is meant by "available status" so as best understood by the examiner, this claim is directed to the purchasing of a disk that is in inventory. Also, because a disk that has a status of "Awaiting release" from the specification is not available yet, this leads the examiner to conclude that "available status" has to be for a disk in inventory at the present time. Applicant goes on to claim that an optimized price and a future price are determined for the disk with the available status. This is where the examiner has a problem. The determination of a future price is only disclosed with respect to disks that are not released yet (not available). This is discussed with respect to figure 5A, paragraphs 46-49. It is not disclosed that there is any future price generated for a disk that is available. If the disk is available the price determination seems to be that as disclosed in paragraphs 33,34. It is not disclosed that any future price is determined for a disk that is available, only when the disk is not release yet (figure 5A). The examiner concludes claim 25 to contain new matter because the specification as originally filed does not provide support for what is claimed.

For claim 26, the specification as originally filed does not provide support for what is claimed. It is not disclosed that for a disk that is available (not the awaiting release embodiment) an optimized and future price are determined, and it is not disclosed that the user queue structure is searched as claimed. The specification discloses that for a disk awaiting release demand forecasting is performed where box office receipts for the DVD title and rental patterns of prior DVD titles with similar box office receipts are

used. Even if applicant were claiming the price determination for a disk awaiting release, with respect to an optimized and future price, no searching of the user queue data structures is disclosed as claimed. The examiner concludes the claim to be reciting new matter.

For claim 27, the specification as originally filed did not disclose that the frequency of appearance is determined by tallying the frequency of checked out status and available status as claimed. The closest the specification comes to support for this limitation is where it discloses that that the historical and current rental patterns are looked at but this portion of the specification did not state what is claimed. Where is this supported in the specification as originally filed? Searching a rental patter both historical and current does not seem to provide support for the searching of checked out disks and available disks.

4. Claims 23-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

For claim 23, it is not clear how the optimized purchase price is being generated. It is claimed that the frequency of the occurrence of the disk is searched and then the optimized price is displayed to the user. How is the optimized price determined after the frequency of occurrence has been determined? This is not disclosed and one of skill in the art would be left to guess as to how to determine the price. Undue experimentation

would necessarily be involved because one would not have any idea how the price is determined from the resulting frequency number. If it is determined that the frequency for a given disk is 150 times, as opposed to another disk that is 50 times, how is this used to generate the optimized purchase prices? It is not clear how the resulting number of frequency occurrence is used to generate a price. The examiner concludes this claim to be non-enabled as undue experimentation would be involved to figure out how to practice the claimed invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 23-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 23,25, because the specification makes no mention at all of the status of "available" and "unavailable", it is not known what this means. The specification discloses that the rental queue is divided into three separate lists that are "Checked out", "DVD's in Queue", and "Awaiting Release". The examiner cannot find any disclosure of "available" and "unavailable" as claimed. What is the scope of these terms? Is the unavailable supposed to be the same as "Awaiting Release" or does this mean that the desired disk is in stock but the user already has reached the queue limit and cannot receive any more disks? It is not clear at all as to what these terms mean, mostly because it appears to be new matter not disclosed in the specification and/or applicant is using

new terminology to define the invention and is not being consistent with the language of the specification. The examiner is just left guessing what these terms mean.

For claim 25, what optimized price is being displayed? Is this the optimized price of claim 23 or the one recited in claim 25? Two are recited and the examiner is not clear as to which one is being displayed.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(9) Response to Argument

Applicant has argued that the status identifiers of "available" and "unavailable" are disclosed in the specification as originally filed. The examiner disagrees. Upon review of claim 23 it is noted that one of the status identifiers is called "a checked out status". This is shown in figure 3A and is labeled as 302, "DVD's checked out". The examiner has no problem with this limitation. The other status identifier in figure 3A is shown to be "DVD's in Your Queue" and is labeled 304. Figure 3B has the status identifier of "DVD's Awaiting Release" and is labeled as 306. There is simply no support in the specification as originally filed for the status identifiers of "available" and "unavailable" and figure 3A and 3B do not show them. If the one status identifier of "DVD's checked out" is located above the box that lists the movies that have that respective status, why is it incorrect to conclude that the other status identifiers are also located above the boxes that list the movies that have that respective status, just like the "DVD's

checked out" status identifier? Applicant's arguments do not make sense in view of the original disclosure. The argument by applicant that the terms "available" and "unavailable" refer to whether or not a particular movie has been released by the movie studios has no support in the specification. Where is this stated in the specification as originally filed? The examiner takes the position that the fact that a movie is "unavailable" may also mean that the movie is currently rented out (it has been released) and is not available to you as a user of the movie service. A movie that is unavailable may also mean that you are currently renting the maximum number of movies that the service allows to be rented out at one time, meaning that the movie is not available yet, unless you return another movie so that you can get a new one sent out. The argument that the term "unavailable" is for movies that are not yet released has no support in the specification. The applicant is using claim terminology that was never used on the specification as originally filed. The status identifier of "available" also has not support in the specification as originally filed. At best what applicant is calling "available" corresponds to the originally disclosed status identifier of "DVD's in Your Queue". The examiner believes that the current problems in the claims are due to the fact that applicant is attempting to use new and different terminology form that used in the specification as originally filed, where the newly added terminology does not mean the same as what was originally disclosed. In fact, upon conducting an electronic text word search in the specification as originally filed the terms "status identifier" and "available" and/or "unavailable" in the same paragraph as "status identifier" are not found.

With respect to the argument about the limitation of "searching all of the user's queue data structures", applicant appears to be relying on the language "the rental pattern, both historical and current, of the DVD title across all users is evaluated". One output is disclosed as

being the number of titles checked out and required to be shipped at a given time. This portion does not state that ***all*** of the user's queue data structures are searched as has been claimed. What exactly is meant by "the rental pattern, both historical and current, is evaluated? The historical rental pattern is not listed in any of the rental queues so this is not clear. The current rental pattern seems to be the number that are checked out and the number that are on the list but not checked out yet. *Where is it disclosed that the queue data structure that lists the movies "awaiting release" (status identifier of "DVD's awaiting release") is searched?* That is one of the 3 queue data structures and if the movie is not released yet, it cannot be checked out and is not a current rental. The examiner does not see where the specification as originally filed discloses that the "awaiting release" list is also checked, which is one of the queue data structures? The claim recites "***all*** of the user's queue data structures", which includes all 3, namely, "DVD's in Your Queue", "DVD's checked out" and "DVD's Awaiting release". The examiner does not see support in the specification for what is being claimed.

With respect to the limitation of the additional packaging, applicant is equating the language of "DVD title jewel case" or "jewel case" in figure 4 to "packaging". This is not proper because it is not even clear that the term "DVD title jewel case" is packaging. Also the term packaging has a much more broad definition than a case for a DVD, so even if applicant has disclosed a DVD case, this does not provide support for the broad term of "packaging". Packaging can be anything from wrapping paper for birthday presents to cardboard boxes used in shipping. This is another example of the claims containing terminology that was never disclosed in the applicant as originally filed. The argument is not found as persuasive.

With respect to the 112,1st enablement rejection, as the claims are written, how is one going to determine the optimized price by determining the frequency of occurrence of the disk identifier as claimed? The claim is specifying that the price is determined from just the frequency of occurrence, nothing else, and there is no guidance given on how this is done. There still has been no discussion as to once you determine how many copies are owned or how many are checked out, how is the price determined from there? One of skill in the art would not be able to figure out how to do the optimization as nothing is disclosed about how the actual price is determined based on the frequency of occurrence alone. The examiner feels that there are essential steps missing from the claims that would possibly provide enablement. Just determining now many copies of a movie are rented out, or required to be shipped, does not result in a price of any kind. That result is just a number. The claims make no mention of anything more being done once the frequency of occurrence number is determined. The claims magically result in a price from just a number. This is not enabled and the argument is found to be non-persuasive. Even when viewing figure 5B, if one goes through steps 510 and 512 to determine how many copies of a movie are owned or in use, following the "no" side of the decision branch from step 514, and if the customer is not entitled to a special discount, you arrive at box 530 with a price. Where has the price been calculated? Just evaluating inventory and inventory use does not result in a price, more must be done to arrive at an optimized price. The claims are considered to be non-enabled and the arguments are found to be non-persuasive.

With respect to the 112,2nd paragraph rejection, the argument is found to be non-persuasive for the reasons already set forth by the examiner. Applicant has relied upon the argument traversing the 112,1st rejections, which have been found as non-persuasive.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

DENNIS RUHL
PRIMARY EXAMINER

DR
June 13, 2007

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